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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,937	02/20/2002	Masahiro Nomura	219277US0PCT	2562

22850 7590 08/23/2002

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EXAMINER VB

MURPHY, JENNIFER C

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 08/23/2002 6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant No.

10/049,937

Applicant(s)

NOMURA ET AL.

Examiner

Jennifer C. Murphy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-12 are pending in this application.

Claim Objections

Claim(s) 10-12 are objected to for being substantial duplicates of the claims from which they depend (claim 1). When two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. M.P.E.P. 706.03(k). In the instant claims, the claims mentioned supra are improper use claims in that each claims a different use for the same compound (the compound of formula I): as a "blood glucose-decreasing drug" (claim 10); an "antihyperlipidemia drug" (claim 11); and "an agonist drug of human peroxisome proliferator-activated receptor" (claim 12). These rejections may be overcome by deleting the duplicate claims, for example.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 10, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, wherein each of the claims mentioned supra contains parenthetical marks, rendering each of the claims indefinite because it is unclear what exactly applicant means to claim as the invention. These rejections can be overcome deleting the parentheses, for example.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being un-patentable over Maeda, et al. (EP 0 846 693) or Maeda, et al. (JP 08-333355).

Applicants instantly claim substituted N-benzylthiazolidine-2,4-dione derivatives of the general formula (1) useful for lowering blood glucose and lipid levels. These compounds are also used as agonists at the human peroxisome proliferator-activated receptor.

Determination of the scope and content of the prior art (MPEP §2141.01)

Maeda et al. (EP reference) generically teach substituted N-benzylthiazolidine-2,4-dione derivatives of the general formula (I) that are structurally similar to those instantly claimed, when in the instant claims, R¹ is chlorine or bromine, or lower alkoxy; and R² is hydrogen or chlorine. Generic teaching by the reference can be seen when in the reference, R¹ can equal R² and each or independently be halogen, lower haloalkoxy, nitro or lower alkoxy with carbon atoms of 1-3; R³ can be a lower alkoxy with carbon atoms of 1-3 (see claim 1, pages 19-20).

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The prior art reference does not specifically embody the exact species as those instantly claimed, but generically discloses a generic overlap of possible R substituents. Furthermore, the reference teaches R³ as a substituent from the benzamide group, wherein R³ may be methoxy; the instant claims, however, do not claim that position as a variable but as part of the general formula of compound (1).

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

However, it would have been prima facie obvious for one of ordinary skill in the art at the time of filing to make and use additional compounds from under the prior art genus as taught by Maeda, et al that were structurally similar to those disclosed. *In re Schaumann*, 197 USPQ 5. One of ordinary skill in the art would have been motivated to make compounds mentioned supra because one of ordinary skill in the art would have expected to obtain compounds with same or similar properties, also useful as agents to lower blood glucose levels and/or blood lipid levels. *In re Gyurik*, 201 USPQ 553 where it is prima facie obvious to expect compounds with similar structure to have similar properties.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer C. Murphy, whose telephone number is (703) 305-0159. The examiner can normally be reached on Monday-Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

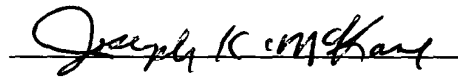
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet

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Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234.

Jennifer C. Murphy
August 22, 2002

A handwritten signature in black ink, reading "Joseph K. McKane", written over a horizontal line.

Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626
Technology Center 1600